UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte BRUCE LEROY BEUKEMA,
RONALD EDWARD FUHS, DANNY MARVIN NEAL,
RENATO JOHN RECIO, STEVEN L. ROGERS,
STEVEN MARK THURBER, and BRUCE MARSHALL WALK

Appeal No. 2006-2275
Application No. 09/731,998

ON BRIEF

Before KRASS, BARRY, and MACDONALD, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

This is a decision on appeal from the final rejection of claims 1-69.

The invention is directed to transferring foreign protocols across a system area network.

Representative independent claim 1 is reproduced as follows:

1. A method for processing foreign protocol requests across a system area network, the method comprising:

receiving a request from a device utilizing a protocol which is foreign to a protocol utilized by the system area network;

encapsulating the request in a data packet formatted for the protocol utilized by the system area network; and

sending the data packet to a requested node via the system area network fabric.

The examiner relies on the following references:

Watson, Jr.	2002/0026517	Feb. 28, 2002
James et al. (James)	6,108,739	Aug. 22, 2000

Claims 1-6, 8-18, 20-29, 31-41, 43-52, 54-64, and 66-69 stand rejected under 35 U.S.C. § 102(e) as anticipated by Watson.

Claims 7, 19, 30, 42, 53, and 65 stand rejected under 35 U.S.C. § 103 as unpatentable over Watson in view of James.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

We have but a single issue before us in the instant case. The two outstanding rejections are based in whole or in major part on the Watson Patent Application Publication 2002/0026517, having a publication date of February 28, 2002, and a filing date of June 29, 2001, or more accurately, on the provisional application No. 60/215,774, filed June 30, 2000, on which the non-provisional Watson Patent Application Publication is based.

There are no arguments before us regarding the merits of the rejections. Appellants' sole argument is that the Watson reference is not a proper reference under 35 U.S.C. § 102/103 because its filing date of June 29, 2001 is after the December 7, 2000

filing date of the instant application, and the June 30, 2000 date of the provisional application No. 60/215,774 cannot be used to anticipate or make obvious the instant claimed subject matter because the effective filing date of a provisional application upon which priority is based is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. § 112 by the provisional application.

Thus, appellants argue, to the extent the examiner relies on the provisional application filing date of June 30, 2000, the examiner has failed to establish that this provisional application is fully supported under the first paragraph of 35 U.S.C. § 112 with respect to the subject matter of the Watson reference which the examiner relies on to reject the claims. It is appellants' contention that the examiner has the burden to establish enablement of the provisional application before the filing date of that provisional application can be used, and, as such, the examiner can only use the filing date of Watson, the non-provisional application, which is June 29, 2001, which date does not predate the filing date of the instant application.

We AFFIRM.

The United States Patent and Trademark Office OG Notice of November 23, 2004, a copy of which is attached to appellants' reply brief, indicated that since applicants would now have access to the Pubic PAIR website at http://portal.uspto.gov/external/portal/pair, the Office has ended the practice of supplying

a copy of the provisional application relied upon to give prior art effect under 35 U.S.C. § 102(e).

Appellants assert that while the provisional application may be accessible *today*, it was not accessible to appellants at the time of the final rejection of July 29, 2004 and at the time appellants were required to make a decision as to whether to timely appeal the rejection.

We agree that the examiner should have provided a copy of the provisional application at the time of the final rejection or, in any event, at any time prior to the November 23, 2004 OG notice. It was not proper for the examiner to withhold a reference the examiner relied on for its effective filing date, even though, allegedly, this reference had the same disclosure as the Watson Patent Application Publication.

That having been said and the examiner having put forth a reasonable rationale for rejection based on a disclosure allegedly the same as the Watson reference (we note that appellants do not question the substantive nature of the examiner's rationale), it is our view that the equities in the instant case favor the examiner's position.

While it is true that the examiner should have provided a copy of the provisional application to appellants, it is our view that appellants could/should have obtained a copy of this reference for themselves when it became apparent that the disclosure of that reference was the critical factor in the outcome of the case. Perhaps the document was

unavailable to appellants at the time of the final rejection and at the time of deciding whether to appeal the examiner's rejection. But the document was clearly available to appellants after November 23, 2004, as per the OG notice. That means the document was easily available to appellants at the time of filing their original principal brief on January 5, 2005, at the time of filing the amended brief of April 26, 2005, and at the time of filing the reply brief on September 8, 2005. Yet, for all of their complaints about how the rejection is improper because the examiner failed to provide a copy of the provisional application, there is no evidence of appellants' attempt to obtain a copy of this document anytime after November 23, 2004.

Rather than merely access the aforementioned website and obtain a copy of the provisional application in question, appellants appear to have exhausted much more time scrounging up a copy of the 2004 OG notice and arguing in the reply brief about how unfair the examiner had been in not supplying a copy of the document.

We find it a bit disconcerting that appellants have chosen to argue that it was the examiner's burden to supply the document and show its enablement vis-à-vis the instant claims, when appellants had more than ample opportunity, at any time during the appeal process, to obtain a copy of the provisional application and argue the merits of the rejections by showing, if they could, with document in hand, that the provisional application did not have the proper support and enablement to permit the June 30, 2000 filing date to be used against the instant claimed subject matter. Instead, it appears to us, that appellants hid their heads in the sand, as it were, refusing to look at the substance of

the provisional application, which, again, was readily available to them anytime after November 23, 2004, and chose merely to argue, not that the reference was not a proper reference, but only that the examiner had not shown, specifically, that the reference was enabling for the purposes of using the provisional application filing date in rejecting the instant claims.

This puts us in the awkward position of having to analyze the provisional application *sua sponte*, having only the examiner's input as to what it discloses and having no input from appellants as to their position on the substance of the document. Since we have no input from appellants in this regard and the examiner's rationale does not appear, on its face, to be unreasonable, we will find for the examiner on the substantive issue, as arguments not made by appellants are deemed waived. We note, specifically, that the examiner, at pages 9-10 of the answer, sets forth the rationale as to why the provisional application is deemed to be fully supported under the first paragraph of 35 U.S.C. § 112, relying on Figures 8 and 9 and paragraphs [0041]-[0043] of Watson and showing the correspondence to page 9, lines 16-24, and Figures 8 and 9 of the provisional application. Even though appellants filed a reply brief in response to the examiner's answer, appellants never substantively refuted the examiner's findings.

Thus, we do not find it to be reversible error on the examiner's part to have not provided appellants with the provisional document in question, even though it would have been proper to do so. We also sustain the examiner's rejections of claims 1-69 under 35 U.S.C. § 102(e) and 35 U.S.C. § 103 because the examiner's rationale does not

appear to be unreasonable and appellants never offer any substantive arguments thereagainst.

Moreover, for appellants' benefit, we attach hereto a copy of the provisional application which took us all of five minutes to download and copy.

The examiner's decision, rejecting claims 1-6, 8-18, 20-29, 31-41, 43-52, 54-64, and 66-69 under 35 U.S.C. § 102(e) and claims 7, 19, 30, 42, 53, and 65 under 35 U.S.C. § 103, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

Errol A. Krass)
Administrative Patent Judge)
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) BOARD OF PATENT
Lance Leonard Barry)
Administrative Patent Judge) APPEALS AND
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Allen R. MacDonald)
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